REMARKS

Claims 1 and 3-16 are pending in the present application. Claims 11-16 have been added to further define the present invention. Claims 11-13 correspond to the non-photosensitive fatty acid silver salt grains recited in claims 1, 2 and 5, respectively. The Examiner seems to recognize that the fatty acid silver salt grains prepared in the closed mixing means is not disclosed in the cited references. The advantageous effects of the grains are shown in the Declaration dated August 28, 2002. Applicant respectfully submits that product-by-process claims 11-16 are allowable in view of the Declaration of record.

Issues under 35 U.S.C. § 112

Claims 1-10 are rejected by the Examiner under 35 U.S.C. § 112, second paragraph, because the term "acid" has been left out of the phrase "non-photosensitive fatty acid silver salt grains" in claims 1, 3, 4 and 5. This "missing" term has been added into claims 1, 3 and 4, although it is already present in claim 5. The addition of the term "acid" is clearly a non-narrowing claim amendment.

Accordingly, in view of the amendment to claims 1, 3, 4 and 5, reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. 112, second paragraph, are requested.

Issues under 35 U.S.C. §§ 102(a) and 103

Claims 1, 3, 5, and 7-9 have been rejected under 35 U.S.C. § 102(a)/103 as being anticipated by or obvious over EP '701. Claim 6 is free of this rejection. Claim 10 has been rejected under 35 U.S.C. § 103(a) as being obvious over EP '701 combined with WO 97/34196 (hereinafter referred to as "WO '196") and EP 021433 (hereinafter referred to as "EP '433"). Claims 4 and 6 have been rejected under 35 U.S.C. § 102(b)/103(a) as being anticipated by or obvious over EP '433 or WO '196.

The present invention is most broadly encompassed by claim 1, which recites a thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty acid silver salt grains wherein the non-photosensitive fatty acid silver salt grains are prepared by mixing and reacting a silver ion-containing solution, the solvent of which is water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which is water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means.

Thus, the present invention is drawn to a product, which is defined by the process by which it is made. Specifically, the product of the present invention requires the presence of non-photosensitive fatty acid silver salt grains that are prepared by

mixing and reacting a silver ion-containing solution and a solution of a fatty acid alkali metal salt in a closed mixing means. With the present invention, the use of a closed mixing means results in a different and superior product than that of the prior art.

As noted above, present claims specifically require that the product be made using a closed mixing means. EP '701 discloses the use of conventional methods, i.e. open mixing, for producing non-photosensitive fatty acid silver salt grains. By using the recited process of claim 1, the resulting product has unique properties compared to the product of EP '701.

In the response of September 11, 2002, Appellant submitted under 37 C.F.R. § 1.132, a Declaration of Inventor Shoji YASUDA. The remarks from the Appeal Brief discussing this Declaration are herein incorporated by reference.

Thus, Applicant has shown that the product of the present invention, when prepared in accordance with the recited process, possesses distinct properties that distinguish the product of the invention from that of EP '701. As such, the product of the present invention, which is different from the product of EP '701, due to the process used to make the product, is not anticipated by the reference.

In addition, the present product possesses unexpected advantageous properties compared to the product of EP '701, such

that the present product is not obvious over the disclosure of EP '701.

The invention of claim 1 is drawn to a thermally processed image forming material containing, in part, a non-photosensitive fatty acid silver salt grains prepared in a closed mixing means. Applicant has shown that a thermally processed image forming material of the invention possesses different properties from the prior art material. As such, the present invention has been shown to be distinct from the prior art. In addition, the present invention has been shown to possess superior properties over the prior art. As such, the invention has been shown to be non-obvious over the prior art.

Claim 10 has been rejected as being obvious over EP '701 combined with WO '196 and EP '433. As discussed above, the products of the present invention are distinct from the products of EP '701 because of the use of a closed mixing means to make the non-photosensitive fatty acid silver grains. The WO '196 reference is relied on for generally teaching the inclusion of nucleating agents. WO '196 fails to teach or suggest the preparation of non-photosensitive fatty acid silver grains using a closed mixing means. As such, WO '196 fails to make up for the deficiencies of EP '701 and the invention of claim 10 is not achieved by combining the references.

Claims 4 and 6 have been rejected under 35 U.S.C. § 102(b)/103(a) as being anticipated by or obvious over EP 021 433 or WO 97/341196. On page 4 of the Office Action of March 13, 2002, the Examiner acknowledges that the references fail to teach the use of a closed mixing means in the preparation of the materials. As discussed above, the use of a closed mixing means results in a different product, which is distinct from and possesses unexpected improved properties compared to materials made with an open mixing means. As such, the material of claim 4 is distinct from and not obvious over the materials of EP '433 and WO '196.

The Examiner alleges that the experiments of the Declaration are insufficient to overcome the rejection over EP '701 because only the organic silver salt dispersion of EP '701 was used in the comparison instead of the total photothermographic material of EP '701. Based on the Examiner's comments, Mr. Yasuda is preparing additional experiments. The experiments are not yet completed. The additional data will be provided as soon as it is received by the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of $930.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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